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10/725,457	12/03/2003	Tomohide Noda	086142-0608	4036

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EXAMINER

FISCHMANN, BRYAN R

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,457

Applicant(s)

NODA, TOMOHIDE

Examiner

Bryan Fischmann

Art Unit

3618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/120,415.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Acknowledgments

1. The Amendment filed 12-14-2004 has been entered.

Divisional Application

2. This Application is a divisional application of Application number 10/120,415 under 37 CFR 1.53(b), as noted on the transmittal dated 12-03-2003.

Specification

3. The disclosure is objected to because of the following:

The Applicant has amended paragraph 0067 of the specification to note that publication 2002-308043 is incorporated by reference. This is considered new matter. Although the above publication is best understood to be a translation of the foreign priority document, there is no guarantee that the above publication is identical to the priority document. For example, the claims of the above publication and the claims of the foreign priority document may be different. Therefore, the addition of the above publication to be incorporated by reference to paragraph 0067 is considered new matter.

Per Section 2163.06 of the MPEP, new matter in the specification should be objected to under 35 USC 132 or 251 and the Applicant is required to cancel the new matter unless he can cite specific support in the originally filed application for the "new matter".

In order to overcome this objection, it is recommended that Applicant delete the above US Patent Application Publication added to paragraph 0067 and instead incorporate the priority document by reference, as was originally done.

The reason that incorporating a foreign priority document by reference was objected to in the last Office Action is that a foreign patent may not be incorporated by reference if it contains "essential material". However, an exception is made when the foreign patent is a foreign priority document from which benefit to an earlier filing date is being made. See Section 608.01(p) of the MPEP. The Examiner was unaware of this "exception" at the time of writing of the last Office Action.

Claim Objections

4. Claims 1, 5 and 6 are objected to because of the following:

A) Claim 1 recites "...a webbing guide for guiding at least one of the sides of the webbing in order to prevent the webbing from shifting along the lateral direction of the opening...".

This recitation is objected to due to the following:

- 1) As best understood, claim 1 is drawn toward Figure 4.
- 2) Figure 4 and associated disclosure in the specification teaches that the opening is up to 1.1 times the width of the webbing.
- 3) Therefore, since the width of the opening is wider than the width of the webbing, there is a lateral clearance between the webbing and the opening.

4) Since there is a lateral clearance between the webbing and the opening, the webbing is able to move, or "shift" laterally within this clearance.

5) Lateral shifting of the webbing, as set forth in the above paragraph is inconsistent with the above claim 1 recitation, which sets forth the webbing is "prevented" from shifting along the lateral direction of the opening.

B) Claim 5 recites "...the webbing passes through the lateral ends of the opening".

The above recitation is objected to, as it does not appear that the Applicant has clearly established that the opening has "lateral ends", as implied by the above recitation.

See also a similar objection to claim 6.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Ando, et al, US Patent 4,480,853.

Ando teaches an insertion member (10) for a vehicle seat belt webbing (12) comprising:

a hole (Figure 3) for pivotally connecting (arrow A) the member to the vehicle;
an opening (50) in the member through which the webbing passes;
a bearing surface over which the webbing slides during retraction and
extraction (portion of 43 directly under the webbing);

wherein the length of the opening is slightly greater than the width of the webbing (Figure 2) so that as the webbing passes through the opening ends of the opening confront left and right sides of the webbing in order to substantially prevent the webbing from shifting laterally within the opening.

Regarding claims 2 and 6, see Figure 2.

Regarding the claim 5 limitation "so that as the webbing passes through, the lateral ends of the opening confront left and right sides of the webbing in order to substantially prevent the webbing from shifting laterally within the opening", it is noted this limitation is drawn toward "functional, or intended use" of the claimed invention. The functional recitation of intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the function or intended use, then it meets the claim. *In re Casey*, 370 F.2d 576, 152 USPQ 235, 238 (CCPA 1967). It is the Examiner's position that the prior art is capable of performing the intended use.

Once this prima facie case has been established, the burden shifts to the applicant to show that the prior art structure does not possess the functionally defined or

intended use limitations of his claimed apparatus. *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ando, et al, US Patent 4,480,853.

Claim 3 recites "...wherein the length of the opening in the longitudinal direction is 1.01 to 1.1 times as large as the width of the webbing". This limitation would appear to be taught by Figure 2 of Ando, though a specific length of the opening in a longitudinal direction and a specific width of the webbing is not explicitly stated by Ando.

However, note that it is considered within the skill level of one of ordinary skill in the art to optimize a range based on prior art general conditions. See Section 2144.04 of the MPEP. Manufacturing the webbing insertion member such that the length of the opening in a longitudinal direction is 1.01 to 1.1 times as large as the width of the webbing is advantageous in that if the length of the opening were 1.00, or less, the webbing would likely tend to bind in the opening. If the length were greater than 1.1 times as large as the width of the opening, the webbing would tend to "meander" back and forth along the length of the opening, possibly impeding the movement of the

webbing relative to the opening, due to "foldover", or "retraction" or "extraction" of the webbing of the belt. Note that it is a generally recognized principle in the prior art that "foldover" of seat belt "webbing" is undesirable.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilizing an opening in an insertion member that has a length that is 1.01 to 1.1 times as large as the width of the webbing.

Examiner's Comments

9. The drawings filed 12-14-2004 have overcome the drawing objections set forth in the last Office Action dated 09-14-2004.

10. The amendment to the specification is objected to, for reasons set forth in this Office Action. As noted above, though incorporation by reference of "essential material" in a foreign patent is not permitted, it is not actually improper to incorporate a foreign patent by reference, as set forth in See Section 608.01(p) of the MPEP.

11. The claim objection set forth in the last Office Action has been overcome by the amendment filed 12-14-2004. However, the amendment also caused additional objections to the claims to be made, as set forth in this Office Action.

12. Claims 1, 2 and 4-6 were rejected in the last and this Office Action as being anticipated by Ando, US Patent 4,480,853. The Applicant has traversed the rejection of these claims as being anticipated by Ando. Applicant's remarks/arguments supporting the traversal of the rejection of claims 1, 2 and 4-6, as set forth in the Amendment filed 12-14-2004, and the Examiner's comments follows:

1) On page 7 the Applicant recites "Ando et al does not disclose a webbing guide disposed in the opening 'for guiding at least one of the sides of the webbing in order to prevent the webbing from shifting along the lateral direction' as called for in clam 1. Furthermore, Ando does not disclose, teach or suggest 'a belt guide for reducing the sliding and gathering of the webbing in the lateral direction of the opening' as called for in claim 4. Still further, it is clear that Ando et al. fails to disclose, teach or suggest an insertion member wherein 'the width of the opening is slightly greater than the width of the webbing so that . . .the lateral ends of the opening confront left and right sides of the webbing in order to substantially prevent the webbing from shifting laterally within the opening' as called for in claim 5.

Examiner's Response:

As best understood, the claims are drawn to the embodiment of Instant Figure 4. This Figure, and associated disclosure in the specification teaches that the webbing is allowed only limited lateral movement within the opening 44C due to the relative widths of the opening and the webbing. Note that the webbing does not "prevent lateral movement" as set forth in claim 1, due to the fact that the width of the opening is wider than the webbing width. This is consistent with the teachings of Ando.

Regarding the recitation of "the width of the opening is slightly greater than the width of the webbing" in claim 5, note that although the specification of Ando may not explicitly "teach" the above recitation, it is obvious that the drawing figures of Ando teaches this limitation. Note that the disclosure of Ando is not limited to the specification of Ando, but also includes the drawing figures of Ando. Note that Figure 2

of Ando clearly teaches that the width of the opening is "slightly greater" than the width of the webbing.

2) On page 7 the Applicant recites "Ando et al. discloses a 'plate-shaped core member' with a webbing insert slot 50 for allowing webbing 12 to extend there through" (Column 3, lines 21-24). However, there is no disclosure regarding the size of the insert slot 50. In particular, there is no disclosure that the insert slot reduces the lateral movement of the webbing. As shown in Fig. 4 of Ando et al, the insert slot 50 is the same as the conventional prior art described in the application (see Application at Figs. 7, 8(a) and 8(b)). Thus, Ando et al. merely discloses an insertion member with the same disadvantages and faults as the prior art. In Ando et al., the webbing 12 will have the tendency to slide and gather in the insert slot 50 in the same manner shown in Fig. 8(b) of the present application. Fig. 4 of Ando also clearly discloses that the lateral ends of the slot 50 do not 'confront left and right sides of the webbing' as called for in claim 5..

Examiner's Response:

As noted above, the disclosure of Ando includes the drawing figures of Ando. Regarding the comparison above of Ando, with Prior Art Figures 7 and 8, note that Prior Art Figures 7 and 8 have a "curved section" at the ends of the opening, which sometimes causes the webbing to "fold over". This would not happen with the opening of Ando, due to the lack of a "curved section" in the opening, as is present in Prior Art Figures 7 and 8. Note that, in contrast, there is much more similarity between Figure 2 of Ando and Instant Figure 4a, then Figure 2 or 4 of Ando and Prior Art Figures 7 and 8, as asserted above by Applicant.

Regarding the Applicant's assertion that the lateral ends of the slot 50 of Ando does not "confront left and right sides of the webbing" as set forth in claim 5, note that this claim 5 limitation is drawn toward "functional, or intended use" of the opening of Ando. It is the Examiner's assertion that Ando will satisfy the intended use set forth in claim 5, as since the structure of Applicant's Instant Figure 4 and Ando's Figure 2 are essentially identical, it follows that the above functional, or intended use as set forth in claim 5 will necessarily be the same as taught by Figure 2 of Ando.

Also, regarding the above discussed claim 5 limitation "...so that the webbing passes through, ...lateral ends of the opening confront left and sides of the webbing in order to substantially prevent the webbing from shifting laterally within the opening", it is noted this limitation is functional language. The functional recitation of intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the function or intended use, then it meets the claim. *In re Casey*, 370 F.2d 576, 152 USPQ 235, 238 (CCPA 1967). It is the Examiner's position that the prior art is capable of performing the recited functions, as the structure disclosed by Applicant and Ando are essentially identical.

Once this prima facie case has been established, the burden shifts to the applicant to show that the prior art structure does not possess the functionally defined limitations of his claimed apparatus. *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

The above comments also apply to Applicant's comments on page 8 that Ando et al. does not disclose an opening wherein 'the height of the opening is slightly larger than the thickness of the webbing so that the webbing cannot gather at either lateral end of the opening' as called for in claim 6.

Conclusion

13. Applicant's amendment necessitated the slightly modified grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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14. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bryan Fischmann whose telephone number is (703) 306-5955. The examiner can normally be reached on Monday through Friday from 9:00 to 5:30.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis, can be reached on (703) 308-2560. On, or about 06 April 2005, the Examiner's new phone number is (571)272-6694. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 3-2-5
BRYAN FISCHMANN
PRIMARY EXAMINER